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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,964	01/11/2005	Michael Lennartz	PD/3-22723/A/PCT	4933
324 7590 06/19/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER POWERS, FIONA	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,964	Applicant(s) LENNARTZ ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/4/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the information disclosure statement filed April 4, 2005, which has been entered in the file. The references on PTO 1449 have been crossed out because the references are not of record in the file.

Applicant's election with traverse of Group I, claims 1 to 4 in the reply filed on May 17, 2007 is acknowledged. The traversal is on the ground(s) that the compounds are novel. This is not found persuasive because a compound encompassed by the instant claims is disclosed in Fogg et al. (Analytica Chimica Acta, 362(2-3), 235-240, 1998). See the rejection below.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5 to 12 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 17, 2007.

The disclosure is objected to because of the following informalities: the headings at the top of Table 3 on page 25 cannot be discerned clearly.

Appropriate correction is required.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogg et al. *Analytica Chimica Acta*, 362(2-3), 235-240, 1998), cited.

The reference discloses the claimed compound of the formula (1) wherein A is a 2-naphthyl-1,5-disulphonic acid residue; n is 0; R₁ is CH₃; D₁ is NR₂R₃ where one of R₂ and R₃ is CH₃ and the other is phenyl; and D₂ is NR₂R₃ where R₂ and R₃ together with the nitrogen form a saturated 6-membered ring which contains an additional nitrogen atom and which is further substituted. Note the dye in Figure 1 where R is DABCO.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogg et al. *Analytica Chimica Acta*, 362(2-3), 235-240, 1998).

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses a structurally similar compound that is useful as a reactive dye. The compound of the reference is structurally similar to the claimed compounds of the formula (1) wherein A is a 2-naphthyl-1,5-disulphonic acid residue; n is 0; R₁ is hydrogen or ethyl; D₁ is NR₂R₃ where one of R₂ and R₃ is CH₃ and the other is phenyl; and D₂ is NR₂R₃ where R₂ and R₃ together with the nitrogen form a saturated 6-membered ring which contains an additional nitrogen atom and which is further substituted. Note the dye in Figure 1 where R is DABCO.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compound of the reference differs from that claimed in that it is a homolog. The group that corresponds to R₁ is methyl instead of hydrogen or ethyl. It has been held that homologs are obvious over one another.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful as dyes would be obtained. The claimed compounds would have been rendered obvious by the

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homolog of the reference in the absence of any unobvious property

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.


The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
June 14, 2007